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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,628	06/26/2006	Naoyuki Onoda	10993.0272	9660
22852	7590	12/16/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROBINSON, CHANCEITY N	
			ART UNIT	PAPER NUMBER
			1722	
			MAIL DATE	DELIVERY MODE
			12/16/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,628

Applicant(s)

ONODA ET AL

Examiner

CHANCEITY N. ROBINSON

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicant's request for reconsideration filed on October 08, 2010 was received. Claim 13 has been cancelled. Claims 1 and 2 have been amended. Claims 10-12 and 14-16 have been withdrawn.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action issued on June 10, 2010.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-9 and 17-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has raised new matter with regards to "wherein the plate comprises a photopolymer as a raw material" in the independent claim
1. The aforementioned limitation was not disclosed or conveyed in the specification. There is no mention of the photopolymer being a raw material in the specification.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1722

6. Claims 1-9 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 recites the limitation of "the plate comprises a photopolymer as a raw material". The limitation of "the plate comprises a photopolymer as a raw material" is unclear. It is not clear how the photopolymer can be a raw material. There is no definition of raw material in the specification. The specification does not clearly define "a photopolymer as a raw material" as applicant contends.

7. Claims 1-9 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language, "selected from" recited in independent claim 1 and dependent claim 3 is improper Markush claim language. The claim language should recite "selected from the group consisting of" in claims 1 and 3. Correction is required.

Claim Rejections - 35 USC § 103

8. Claims 1-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuji (US 2002/0182543 A1) in view of Wallbillich (US 4,876,118).

Fuji discloses a method (abstract) for producing a water-developable photopolymer plate for letterpress printing plate [0001] comprising an exposure step [0009 and 0076], a development step [0012, 0046-0047 and 0060-0062] and post-exposure step [0072 and 0081]. The plate comprises a photopolymer (photosensitive resin A made by Asahi Kasei Corp F-320; [0076 and 0080]). The method further

comprises a contact step during or after the exposure step and irradiation step with actinic light during or after the contact step [0009, 0018 and examples 1 and 2].

Fuji does not explicitly disclose that the photopolymer is a raw material as recited in instant claim 1 or that the photopolymer comprises a binder polymer comprising a mixture of a polar group-containing polymer and a hydrophobic polymer, an ethylenically unsaturated compound; and a photopolymerization initiator as recited in claim 2. However, Fuji discloses that the photopolymer is from the photosensitive resin composition F-320 made by Asahi Kasei Corp [0076, 0080 and 0085], which includes a binder polymer, an initiator and an ethylenically unsaturated compound. Also, It is noted that instant disclosure recites that the photopolymer is from the photosensitive resin composition F-320 made by Asahi Kasei Corp in paragraph [0114 in the pgpub or example 18]. Since the photosensitive resin composition are the same for the instant disclosure and Fuji, then the photopolymer of Fuji is a raw material as recited in claim 1 and the resin composition comprises binder polymer comprising a mixture of a polar group-containing polymer and a hydrophobic polymer, an ethylenically unsaturated compound as recited in claim 2.

Fuji does not explicitly disclose that the contact step brings the photopolymer plate into contact with a liquid comprising a silicone compound and/or fluorine compound modified with a reactive functional group. Fuji discloses the contact step includes spraying the developing liquid on the photopolymer plate [0009 and examples]. The developing liquid containing a silicone mixture [0076] or an aqueous developing liquid comprises of water, surfactant, organic carbonyl compound, hydrogen abstracting agent and other components that do not impair the effect of the invention [0045-0059].

The purpose of Fuji is the development of a method for developing a photosensitive letterpress plate that reduces the cost to treat worn out developing liquid and to give sharp printing results [0008-0009].

However, Wallbillich discloses a gravure printing plate (column 1, lines 5-11) that is contacted with a liquid comprising a silicone compound modified with one or more reactive functional groups (column 3, lines 36-51) and/or fluorine compound that is a compound in which the hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms (column 2, line 59- column 3, line 34). Examiner notes that Wallbillich and Fuji are analogous art in printing plate technology.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include/modify the developing solution of Fuji to comprise a silicone compound modified with one or more reactive functional groups and/or fluorine compound that is a compound in which the hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms as disclosed by Wallbillich in view aiding in eliminating damages to the printing plate and undesirable impression.

Response to Arguments

9. Applicant's arguments filed 10/08/2010 have been fully considered but they are not persuasive. Applicant principle argument is that there is nothing improper or indefinite with the recited language "selected from," and a Markush phrase is not required when reciting alternative embodiments. Claim 1 identifies a group of alternative reactive functional groups that is/are used to modify the recited silicone compound. As this language is clear and definite, this rejection should be withdrawn.

Art Unit: 1722

10. Examiner respectfully disagrees. Claim 1 of the instant application recites, “ a liquid comprising a silicone compound modified with one or more reactive functional groups selected from a hydroxy group, a carbinol groupan aromatic hydrocarbon group substituted with a hydroxy group ...” The reactive functional groups are Markush groups, which requires the correct Markush claim language, “ selected from the group consisting of...”. Therefore, the rejections are maintained. It is noted applicant did not present any arguments with regards to dependent claim 3 as being indefinite. Therefore, the rejections are maintained.

11. Applicant principle argument is the proposed addition of Wallbillich would render the printing plate of Fuji unsatisfactory for its intended purpose. Fuji discloses a developing liquid. Wallbillich relates to printing plate that is filled with a correcting agent. The pasty material of Wallbillich must be completely resistant to the printing ink solvents. Fuji teaches that a detergent is preferably contained in a developing agent. The detergent contained in the developing agent is sprayed on the entire plate, not only the non-printing surface of the printing plate, but also the printing surface that is necessary to be filled with ink during the printing process. Since the fluorinated olefin polymer if Wallbillich is resistant to the printing ink, it would act to destroy the printing surface to accept ink if it were added to the developing liquid taught by Fuji, and render it unsatisfactory for its intended purpose. This is clearly a situation where the art teaches away from the addition of a silicone compound of Wallbillich to the developing liquid of Fuji.

12. Examiner respectfully disagrees. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner

recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). Both Fuji and Wallbillich are analogous art in the printing plate. Fuji discloses a step of bring a plate in contact with a "liquid" as recited in the instant claims. See paragraph 0009 and examples. Also, Wallbillich discloses a step of bring a plate in contact with a "liquid" as recited in the instant claims. See column 3, lines 36-51. The instant claims only recite a photopolymer plate is brought in contact with a liquid. There is no definition or disclosure recited in the instant claim as to what type of "liquid" is being in contact with the plate as argued by the applicant i.e. a "developing liquid" or "pasty material" or "ink". Fuji discloses that liquid may contain other components (i.e. surfactant, alcohol or surface treatment agent) as long as they do not impair the effect of the invention [0045]. Fuji discloses the developing liquid has a sufficiently low solubility or emulsifying action for the unhardened photosensitive resin to be removed and easily enables regeneration of the developing liquid [0045]. Wallbillich discloses a plate (column 1, lines 5-11) that is contacted with a liquid comprising a silicone compound modified with one or more reactive functional groups (column 3, lines 36-51) and/or fluorine compound that is a compound in which the hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms (column 2, line 59-column 3, line 34). The liquid of Wallbillich that includes the silicone compound

modified with one or more reactive functional groups is used to aid in eliminating damages to the printing plate and undesirable impression. Therefore, it would have been obvious to modify the liquid of Fuji to include the liquid of Wallbillich in order to easily removed the unhardened resin and eliminating the damages of the printing plate. Therefore, the rejections are maintained.

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHANCEITY N. ROBINSON** whose telephone number is (571)270-3786. The examiner can normally be reached on Monday to Friday (with every other Friday off): 9:00 am-6:00 pm eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N Robinson/

Examiner, Art Unit 1722

/Cynthia H Kelly/

Supervisory Patent Examiner, Art Unit 1722